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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,757	03/25/2004	Masanori Hashimoto	FUJY 21.080	5866
26304      7590      09/10/2008 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585				
EXAMINER				
HUYNH, NAM TRUNG				
ART UNIT		PAPER NUMBER		
2617				
MAIL DATE		DELIVERY MODE		
09/10/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/808,757

**Applicant(s)**

HASHIMOTO ET AL.

**Examiner**

NAM HUYNH

**Art Unit**

2617

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,5-15,21 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,8,9,13,14,21 and 26 is/are rejected.
- 7) ☒ Claim(s) 6,7,10-12 and 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 7/1/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 7/1/2008 has been entered.

### ***Information Disclosure Statement***

2. The information disclosure statement (IDS) submitted on 7/1/2008 has been considered by the examiner.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1, 2, 5, 21, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan et al. (US 2003/0040314) (hereinafter Hogan) in view of Minagawa (US 6,510,318).

Regarding claim 1, Hogan teaches a terminal status control system comprising:

a registration table in which information concerning a terminal that is allowed to use a specific base station is registered (paragraphs 12, 43; database or list);

a judging unit judging whether a terminal that has entered a cell of the specific base station is the terminal registered in the registration table by referring to the registration table (paragraphs 12, 43); and

a control unit, if the terminal is the registered terminal, placing the terminal under a communicable status using the specific base station, and if not, placing the terminal under an incommunicable status using the specific base station (paragraphs 45, 46; the core network determines whether the terminal is permitted or not permitted to register in the location area)

wherein the terminal is constructed so as to transmit the location updating request when a location area identifier received from a base station is changed due to an inter-cell movement (paragraph 43), and

However, Hogan does not explicitly teach the terminal status control system further comprises:

a giving unit giving the specific base station a location area identifier for the specific base station that is different from location area identifiers broadcasted in cells adjacent to the cell of the specific base station as a location area identifier that the specific base station broadcasts in the cell thereof, and

wherein the giving unit is provided in a base station control apparatus that manages and controls the specific base station,

the base station control apparatus includes a conversion unit converting a location area identifier of a location area, to which the specific base station belongs, contained in broadcast information, which the base station control apparatus receives from a location management apparatus managing the location of each terminal existing in the location area, to which the specific base station belongs, and transfers to the specific base station, into the location area identifier for the specific base station.

Minagawa teaches a giving unit giving the specific base station a location area identifier (zone code) for the specific base station that is different from location area identifiers broadcasted in cells adjacent to the cell of the specific base station as a location area identifier that the specific base station broadcasts in the cell thereof (column 3, lines 53-59; figure 1), and

wherein the giving unit is provided in a base station control apparatus that manages and controls the specific base station (figure 1, item 1),

the base station control apparatus includes a conversion unit converting a location area identifier of a location area (location registration area), to which the specific base station belongs, contained in broadcast information, which the base station control apparatus receives from a location management apparatus managing the location of each terminal existing in the location area (column 4, lines 32-38), to which the specific base station belongs, and transfers to the specific base station, into the location area identifier for the specific base station (location code) (column 5, lines 20-50; figure 6, each base station is given a new location code based on the location registration area to be constructed thus converting a location area identifier of an area into a location area identifier for a specific base station).

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the invention of Hogan, to include a controller that gives location area identifiers to specific base stations and converts the area identifiers to identifiers for the specific base stations as taught by Minagawa, in order to dynamically adjust the size of the location areas for registration which in turn suppresses location registration traffic and increases network resources.

Regarding claim 2, Hogan teaches with reception of a location updating request transmitted from the terminal as a trigger, the judging unit judges whether the terminal is the registered terminal by acquiring base station specifying information for specifying the base station that received the location updating request from the terminal and

identification information of the terminal, and judging whether the base station specifying information and the terminal identification information are registered in the registration table, and

if the terminal is the registered terminal, the control unit approves the location updating request from the terminal, and if not, rejects the location updating request from the terminal (paragraphs 45, 46).

Regarding claim 5, Minagawa wherein the conversion unit converts the location area identifier for the specific base station contained in the location updating request from the terminal, which the base station control apparatus receives from the specific base station and transmits to the location management apparatus, into the location area identifier of the location area to which the specific base station belongs (column 4, lines 20-25, lines 32-38; figure 6).

Regarding claim 21 Hogan teaches the terminal status control system further comprises:

an internet protocol (IP) interface portion that is provided between the specific base station and the base station control apparatus that manages and controls the specific base station and performs IP communication there between (figure 6; connections between RNC and base stations), and

an apparatus that is provided between the base station control apparatus and a switchboard of a network including other base station control apparatuses and the location management apparatus, and performs conversion between the IP interface and another interface applied to the switchboard (figure 6, item 20; GPRS node).

Regarding claim 26, Hogan teaches the specific base station is connected to the base station control apparatus via an Internet service provider network (figure 6, item 14).

6. Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan et al. (US 2003/0040314) (hereinafter Hogan) in view of Minagawa (US 6,510,318) as applied to claim 1 above, and further in view of Tsukagoshi (US 6,058,311).

Regarding claim 8, the combination of Hogan and Minagawa teaches the limitations of claim 1 and teaches the registration table and the judging unit are provided in the base station control apparatus, and

the judging unit acquires the identification information of the specific base station managed by the base station control apparatus as the base station specifying information (paragraph 43),

However, the combination does not teach if identification information of the terminal contained in the location updating request received from the specific base station by the base station control apparatus is temporary identification information, acquires identification information unique to the terminal by inquiring of the terminal, and judges whether the base station specifying information and the identification information unique to the terminal are registered in the registration table. Tsukagoshi teaches identification information of the terminal contained in the location updating request received from the specific base station by the base station control apparatus is



temporary identification information, acquires identification information unique to the terminal by inquiring of the terminal, and judges whether the base station specifying information and the identification information unique to the terminal are registered in the registration table (column 3, lines 10-37). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Hogan and Minagawa to include the use of temporary identifiers for location updates, as taught by Tsukagoshi, in order to add security when subscriber information is sent to the network preventing an outsider from discovering the unique identifier of the mobile station.

Regarding claim 9, Hogan teaches the base station control apparatus receives the location updating request from the specific base station, the judging unit performs the judging processing before the location updating request is transmitted to the location management apparatus, and if it is judged as a result of the judgment by the judging unit that use of the specific base station is allowable, the base station control apparatus transmits the location updating request to the location management apparatus, and if not, transmits updating rejection to the terminal with respect to the location updating request (paragraphs 45, 46).

7. Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hogan et al. (US 2003/0040314) (hereinafter Hogan) in view of Minagawa (US 6,510,318) as applied to claim 1 above, and further in view of Saada et al. (US 6,493,555) (hereinafter Saada).

Regarding claim 13, the combination of Hogan and Minagawa teaches the limitations set forth in claim 1, but does not explicitly teach that the base station control apparatus that controls the specific base station uniformly rejects handover requests from other base station control apparatuses. Saada teaches the cooperation of BSCs in determining whether a handover request should be accepted or rejected (column 2, lines 14-51). Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Hogan and Minagawa to include the capability to reject or accept handover requests from other BSCs, as taught by Saada, in order to improve cooperation of entities of the network during handover.

Regarding claim 14, the combination of Hogan and Minagawa teaches the limitations set forth in claim 1, but does not explicitly teach with respect to a handover request from another base station control apparatus, the base station control apparatus that controls the specific base station judges whether a terminal that is a target of the handover request is the terminal allowed to use the specific base station based on registration contents of the registration table, wherein if the target terminal is the allowed terminal, the base station control apparatus approves the handover request, and if not, rejects the handover request. Saada teaches the base station control apparatus that controls the specific base station judges whether a terminal that is a target of the handover request is the terminal allowed to use the specific base station based on registration contents of the registration table, wherein if the target terminal is the allowed terminal, the base station control apparatus approves the handover request, and if not, rejects the handover request (column 2, lines 14-51). Therefore it would have been

obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Hogan and Minagawa to include the capability to reject or accept handover requests from other BSCs, as taught by Saada, in order to improve cooperation of entities of the network during handover.

***Allowable Subject Matter***

8. Claims 6, 7, 10-12, and 15 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Response to Arguments***

9. Applicant's arguments with respect to claims 1, 2, 5, 8, 9, 13, 14, 21, and 26 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NAM HUYNH whose telephone number is (571)272-5970. The examiner can normally be reached on 8 a.m.-5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/George Eng/  
Supervisory Patent Examiner, Art Unit 2617

NTH  
9/8/08